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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,083	04/27/2001	Oliver Nickel	Beiersdorf 721-KGB	9696
27384	7590	04/14/2004	EXAMINER	
KURT BRISCOE NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/844,083	NICKEL, OLIVER 	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor S Chang	1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/15/2004</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicants' terminal disclaimer amendments and remarks filed on 3/15/2004. Applicants' amendments to the specification, claims 9 and 11 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Terminal Disclaimer***

4. The terminal disclaimer filed on 3/15/2004 has been accepted. However, the terminal disclaimer filed on 3/15/2004 does not include the co-pending Application No. 09/844,084, which is inconsistent with Applicant's statement that terminal disclaimers over both co-pending Application No. 09/431,849 and Application No. 09/844,084 will be submitted (Remarks filed 9/29/2003, page 10). Further, in view of Applicant's prior unaccepted terminal disclaimer filed 9/29/2003, which on the contrary only disclaims Application No. 09/844084, only requires minor formality correction, the double patenting rejection over 09/844084 was not instated, and the Examiner only requested correction (see Paper No. 120903, page 2). Since Applicant appears to have ignored the Examiner's specific request for correction, the Examiner notes that the terminal disclaimer filed on 3/15/2004 is incomplete and also non-responsive. As such, the

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double patenting rejection over Application No. 09/844,084, now U.S. Patent No. 6723406, must be reinstated as follows.

### ***Specification***

5. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

In particular, the Examiner notes that the newly amended Specification appears replete with vague and indefinite terms, such as "good adhesion", "good absorption", "very same edge", etc. (Amendment, page 2). The Examiner suggests that a rewrite with clarifying terms may be appropriate.

### ***Claim Rejections - 35 USC § 112***

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Despite of the amendment, the Examiner notes that the claims are still replete with vague and indefinite terms. For example:

In claim 1, line 3, and throughout, the term "composition" is vague and indefinite. The Examiner repeats prior suggestion (see Paper No. 120903, page 3) to insert the term --layer--, so as to clarify the structural relation of the pressure sensitive adhesive

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to other claimed elements. For example, in claim 1, lines 5-6, it is unclear as to how a "composition" has an edge region. Clarification is requested.

In claim 1, line 4, and throughout, the Examiner repeats (see Paper No. 120903, page 3) that the phrase "masking material" appears vague, indefinite and confusing. In particular, the Examiner notes that the phrase "masking material" lacks any inherent structural element. As such, in the absence of structural limitation, the phrase "masking material" fails to particularly point out and distinctly claim the subject matter. Regarding Applicant's argument that "a person skilled in the art would understand the meaning of the terms when read in light of the specification and Figures 1-3" (Remarks, page 11, second paragraph), the examiner notes that although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. See *In re Van Geuns*, 988 f.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Clarification is again requested.

In claim 1, line 10, the phrase "on a side thereof" lacks a proper antecedent basis, i.e., it is unclear what is the scope of "a side thereof".

In claim 4, line 3, the Examiner repeats (see Paper No. 120903, page 3) that "capable of" element does not constitute a limitation in any patentable sense.

Finally, please correct any other informalities which may have been overlooked.

### ***Double Patenting***

7. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Application No.

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09/844,084, now U.S. Patent No. 6723406. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both direct to essentially the same subject matter and the same scope of claimed elements.

8. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 8/18/2003, and the absence of Application No. 09/844084 in the Terminal Disclaimer as set forth above, prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1900~~  
1700

*Daniel Zinker*